

Remarks

The Office Action of July 18, 2005 has been carefully reviewed and this paper is responsive thereto. In the Examiner's action, claims 1 – 8 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pat. No. 2,767,113 issued to Bower ("Bower") in view of U.S. Pat. No. 3,290,854 issued to McMurray ("McMurray").

Claims 1 – 8 remain, and are unchanged in this application. The Applicant believes that the following remarks, directed to the structural features of the claimed invention, address the grounds for rejection. Other references of record have been noted, but none is believed to be pertinent to the Applicant's invention as claimed. In light of these remarks, the Applicant respectfully request reconsideration of the application, withdrawal of the rejections and allowance of all pending claims.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1 – 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bower in view of the McMurray. In reply, Applicant respectfully asserts that the present invention is nonobvious over Bower in view of McMurray, and submit the following remarks.

Bower discloses a plant tie having wire reinforcement in a water-proof tie strip and a method of effecting a bond between the wire and the strip. McMurray discloses plastic covered wire ties having improved tying characteristics which are particularly adapted for sealing plastic and open mesh type bags. Specifically, McMurray teaches a wire tie with serrated edges as a structural feature that assist in holding the tie in place by mechanically interlocking the wire strands with each other and with the material to be tied. (See McMurray Col. 2, ll. 64 – 69) ("... when the tie is place around the neck [of the bag] . . . and then twisted, projections 5 not only

BEST AVAILABLE COPY

interlock with each other but also entangle with the mesh thereby preventing the tie from slipping off the neck of the bag.”) (emphasis added).

Respectfully, neither Bower nor McMurray disclose, teach, or suggest a wire tie with claimed structural feature of a frictional-type textured surface which prevents slippage, thus they fail to disclose, teach or suggest all the claim limitations of the present invention. See MPEP 706.02(j) (“To establish a *prima facie* case of obviousness, three basic criterion must be met. ... Finally, the prior art reference[s] ... must teach or suggest all the claim limitations”). Because the prior art fails to disclose, teach or suggest this claim limitation, the present invention is nonobvious over Bowers and McMurray.

At page 3, the Office Action states that “[i]t would have been obvious to the skilled artisan to modify the wire tie taught by Bower by including serrations in the plastic coating to improve the holding power of the tie.” However, there is nothing in the prior art that suggests a combination of Bower and McMurray to arrive at the structure of the claimed invention. See MPEP 706.02(j) (“To establish a *prima facie* case of obviousness, three basic criterion must be met. First, there must be some suggestion or motivation ... to modify the reference or to combine reference teachings”).

Here, there is no suggestion in the prior art to combine Bower and McMurray to arrive at the claimed invention. Specifically, there is no suggestion to modify the mechanical interlocking of McMurray to achieve the frictional-type wire tie structure of the present invention. Absent a suggestion to combine Bower and McMurray to arrive at the claimed invention, claims 1 – 8 are nonobvious. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the

BEST AVAILABLE COPY

Page 3 of 4

combination." *In re Gelger*, 815 F.2d 686, 688 (Fed. Cir. 1987), quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).

Furthermore, there is nothing in the prior art that suggests a reasonable expectation of successfully combining Bower and McMurray to arrive at the claimed invention. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criterion must be met. ... Second, there must be a reasonable expectation of success"). In particular, McMurray discloses a serrated wire tie that is secured by interlocking tie ends and entangling the wire tie with the mesh plastic netting of a bag (such as a produce bag). (See McMurray, Col. 1, ll. 25 - 41; Cbl. 2, ll. 57 - 69.) A frictional wire tie may tend to abrade and damage the neck of the mesh bag in contrast to the serrated wire tie. As such, the modification of McMurray to combine it with Bowers would impermissibly alter the intended operation of the reference. See *In re Ratti*, 270 F.2d 810, 813 (C.C.P.A. 1959) (Combination or modification required to arrive at the claimed invention cannot change the intended operation of the reference).

For these and other reasons, reconsideration and allowance of the pending claims are respectfully requested.

Conclusion

Applicant has addressed all rejections and objections and respectfully submits that the instant application is in condition for allowance.

Dated: October 31, 2005

By:

Respectfully submitted,

Wendell W. Harris

Wendell W. Harris

Registration No. 55,881

BANNER & WITCOFF, LTD.

10 S. Wacker Drive, Suite 3000

Chicago, IL 60606-7407

Tel: 312-463-5000, Fax: 312-463-5001

BEST AVAILABLE COPY

Page 4 of 4